

Applicants: MERON, Gavriel et al.
Serial No.: 10/036,490
Attorney Docket No.: P-2038-US1

REMARKS

Applicants have carefully studied the Office Action. This paper is intended to be fully responsive to all points of rejection and objection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Status of the Claims

Claims 1-5, 7-11, 14-16, 18-22, 46 and 50 are pending in the Application. Claims 23-44 and 47-48 have previously been withdrawn from consideration, without prejudice or disclaimer. Claims 6 and 17 have previously been canceled, without prejudice or disclaimer. Claims 12, 13, 45 and 49 have been canceled, without prejudice or disclaimer. Claims 1-3, 21 and 46 have been amended.

Voluntary Amendment of Claims

Applicants have amended claims 1-3, 21 and 46, to clarify what the Applicants regard as the invention.

Applicants respectfully submit that the Amendment to claims 2-3 is not intended to limit the scope of the claimed invention and have not been made in response to the rejections raised by the Examiner in view of the prior art.

No new matter has been added by the Amendment to claims 1-3, 21 and 46.

In-Person Interview Summary

Applicants would like to thank the Examiner for the courtesy of the in-person interview with Caleb Pollack, an attorney of record, and Rachel Bentov, a representative of the Assignee, on November 10, 2004.

During the interview, Applicants' representatives and the Examiner discussed Kovacs et al., United States Patent Number 5,833,603 ("Kovacs"), Desai et al., United States Patent Number 5,362,478 ("Desai"), and Atarashi et al., United States Patent Number 6,162,469 ("Atarashi").

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Applicants' representatives proposed claim amendments to distinguish over the prior art rejections of record. Applicants' representatives argued, *inter alia*, that the prior art references may not be combined for the purpose of an obviousness rejection under 35 USC §103.

The Examiner indicated that he would positively reconsider the outstanding rejections in view of the proposed claim amendments and in view of Applicants' arguments.

The proposed amendments are reflected in the claim amendments above.

Claim Rejections under 35 USC §102(b)

The Examiner rejected claims 1-2, 4, 7-8, 14-16, 18-22 and 49-50 under 35 USC §102(b) as being anticipated by Kovacs. Applicants respectfully traverse this rejection.

As is well established, in order for a claim to be anticipated by the prior art, each and every element and feature of the claim must be included in a single prior art document.

Amended independent claim 1 recites, *inter alia*, "an autonomous swallowable capsule comprising at least a solid support". Kovacs does not disclose, teach or suggest at least this feature of the claimed invention.

Applicants submit that the term "autonomous swallowable capsule", recited in amended independent claim 1, has ample support in the Specification. For example, the Specification describes on page 4, lines 4-5 and 14-15, that "The present invention further relates to a swallowable capsule comprising the system of the invention. ... The swallowable capsule passes through the entire digestive tract operating as an autonomous video endoscope". Furthermore, the Examiner stated, in paragraph 8 of the Office Action, that Kovacs "does not teach a swallowable capsule".

Therefore, Kovacs does not anticipate independent claim 1, as amended.

In view of the above, Applicants respectfully submit that amended independent claim 1 meets the novelty requirements of 35 USC §102(b) and request that the rejection under this section be withdrawn.

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Claims 2, 4, 7-8, 14-16, 18-22 and 50 are dependent from amended independent claim 1, and include all the features of amended independent claim 1 as well as additional distinguishing features. Therefore, claims 2, 4, 7-8, 14-16, 18-22 and 50 are likewise allowable.

In view of the above, Applicants respectfully request that the rejection of claims 1-2, 4, 7-8, 14-16, 18-22 and 50 under 35 USC §102(b) as being anticipated by Kovacs be withdrawn.

Claim Rejections under 35 USC §103(a)

The Examiner rejected claims 3, 5, and 46 under 35 USC §103(a) as being unpatentable over Kovacs in view of Desai. Applicants respectfully traverse this rejection.

According to M.P.E.P. §2142, "In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (emphasis added)

Applicants respectfully submit that the first of the above-mentioned criteria is not met, as neither Kovacs nor Desai show a suggestion or motivation to modify the references or to combine references teachings. Furthermore, at the time the invention was made, there was no motivation or suggestion in the art to combine the non-mobile, implantable transponder of Kovacs with the swallowable capsule of Desai.

Applicants further submit that at the time the invention was made, it was improper to combine the teaching of Kovacs with the teaching of Desai, since these two references belong to different, non-related fields: Kovacs is a reference in the field of non-mobile, implantable transponders; whereas Desai is a reference in the field of Magnetic Resonance Imaging (MRI) systems.

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Applicants further submit that the second of the above-mentioned criteria is not met, as the combination of Kovacs and Desai would yield an inoperable device. The capsule described in Kovacs is clearly intended to be implanted, as stated by the Examiner in the Office Action (lines 2-3 of paragraph 4). An attempt to swallow the Kovacs capsule, instead of implanting it, would make the Kovacs capsule inoperable, *inter alia*, because an operator may not know the exact location of the Kovacs capsule (once it is swallowed) in order to radiate energy towards it. As a result, the Kovacs capsule may not receive enough of the external energy that it needs, and will not be able to transmit data to the outside world. In fact, the non-mobile, implantable capsule to which Kovacs is directed is not needed, and is in fact detrimental, to the operation of the in-vivo device of the claimed invention. Therefore, the second of the above-mentioned criteria is not met; moreover, no "reasonable expectation of success" can be found in the prior art, as required by the above-mentioned criteria of M.P.E.P. §2142.

Applicants further submit that although Desai teaches a capsule which may be swallowed, Desai clearly does not teach a swallowable capsule having the type, the features or the characteristics of the in-vivo imaging capsule of the claimed invention. The "capsule" described by Desai is merely a simple microscopic container for carrying magnetic material, having different design constraints and different operational features than those of the in-vivo imaging capsule of the claimed invention, which may include, for example, a power source, an imager or camera, a transmitter, circuitry, and other components. Although Desai does teach the word "capsule", Desai describes a mere container for magnetic material, and Desai clearly does not teach the in-vivo imaging or sensing capsule of the claimed invention.

Applicants further submit that it is improper to consider Desai as being relevant prior art. It is well established that "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was considered." (MPEP 2100-122; See also *In Re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992)). Generally, the claimed invention is directed to, *inter alia*, an in vivo sensing

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system or an in-vivo imaging system, wherein a swallowable capsule performs the imaging or the sensing. In contrast, Desai is directed to a Magnetic Resonance Imaging (MRI) system, in which an external device uses a non-invasive technique to transmit radiation to detect certain atomic nuclei at an applied magnetic field strength (see Desai, column 1, lines 6-8 and 21-32). The constraints and problems in the field of the claimed invention are significantly different than those of the field of MRI to which Desai is directed. Therefore, Desai may not be properly used in combination with Kovacs to render the claimed invention obvious.

In view of the above, Applicants respectfully request that the rejection of claims 3, 5, and 46 under 35 USC §103(a) as being unpatentable over Kovacs in view of Desai be withdrawn.

The Examiner rejected claims 9-11 under 35 USC §103(a) as being unpatentable over Kovacs in view of Atarashi. Applicants respectfully traverse this rejection.

According to M.P.E.P. §2142, in order for a claim to be rendered obvious by the prior art, "the prior art references must teach or suggest all the claim limitations".

Each of claims 9-11 depends from amended independent claim 1, which recites, *inter alia*, "an autonomous swallowable capsule comprising at least a solid support". Kovacs and/or Atarashi, alone or in combination, do not disclose, teach or suggest at least this feature of the claimed invention. Therefore, without conceding the appropriateness of the combination, Kovacs and/or Atarashi clearly do not render claims 9-11 obvious.

In view of the above, Applicants respectfully request that the rejection of claims 9-11 under 35 USC §103(a) as being unpatentable over Kovacs in view of Atarashi be withdrawn.

Conclusion

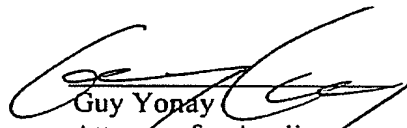
In view of the foregoing amendment and remarks, Applicants respectfully submit that claims 1-5, 7-11, 14-16, 18-22, 46 and 50 are deemed to be allowable. Their favorable reconsideration and allowance are respectfully requested.

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Should the Examiner have any question or comment as to the form, content or entry of this paper, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

No fees are believed to be due in connection with this paper. However, if any fees are due, please charge any such fees to deposit account No. 05-0649.

Respectfully submitted,


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